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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,442	06/30/2003	C. Richard Hutchinson	300622009100	4956

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,442	Applicant(s) HUTCHINSON ET AL.	
	Examiner Hope A. Robinson	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-15, 18-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16, 17, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Status

1. Applicant's election without traverse of Group I (claims 1-3, 16-18 and 21-22) on January 31, 2006 is acknowledged. Upon due reconsideration claim 18 was removed telephonically on April 14, 2006 from Group I as it is directed to a non-elected invention (authorized by Jennifer Haynes).

Claim Disposition

2. Claims 1-23 are pending. Claims 1-3, 16-17 and 21-22 are under examination. Claims 4-15, 18-20 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.12(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Specification

3. The specification is objected to because of the following informalities:

(a) The specification is also objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See pages 20 and 31 for example. It is suggested that http:// is deleted.

(b) The specification is objected to because the sequence notation used is improper, see page 31, for "SEQ ID No.1" which should be "SEQ ID NO:1".

Correction of the above is required.

Drawing

4. The drawings filed on June 30, 2003 have been accepted.

Information Disclosure Statement

5. The Information Disclosure Statement filed on January 6, 2004 has been received and entered. The references cited on the PTO-1449 Form have been considered by the examiner and a copy is attached to the instant Office action. However, note that a number of foreign documents have been lined through as they were not found in the application. Applicant is urged to re-submit copies of these references for consideration.

Claim Rejections - 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-3, 16-17 and 21-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention is directed to an isolated, purified and recombinant nucleic acid comprising a polyketide modifying gene that encodes a polyketide modifying enzyme (see claims 1-3), vector, host cell and method of making said polyketide (claims 17-18 and 21-22). The claims do not recite any structural limitations. Therefore, the skilled artisan cannot envision the detailed chemical structure of the nucleic, thus, the claims lack adequate written description. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir.1997). Therefore, a biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence. For example, even though a genetic code table would correlate a known amino acid sequence with a genus of coding nucleic acids, the same table cannot predict the native, naturally occurring nucleic acid sequence of a naturally occurring mRNA or its corresponding cDNA. See *MPEP* 2163.

In addition, MPEP 2163 also state that (citing Amgen, 927F.2d at 1206, 18 USPQ 2d at 1021), "A gene is a chemical compound, albeit a complex one, and it is well established in our law that conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials". Further, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991), states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in *possession of the invention*". The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-Cath* at page 1116). The skilled artisan cannot envision the detailed chemical structure of the encompassed genus of encoded proteins, and therefore, conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993). See MPEP 2163.

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

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7. Claims 1-3, 16-17 and 21-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the nucleic acid set forth in SEQ ID NO: 2 and the disclosure in the art, does not reasonably provide enablement for any nucleic acid. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The enablement requirement refers to the requirement that the specification describe how to make and how to use the invention. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. These factors include, but are not limited to: Quantity of Experimentation Necessary; Amount of direction or guidance presented; Presence or absence of working examples; Nature of the Invention; State of the prior art and Relative skill of those in the art; Predictability or unpredictability of the art and Breadth of the claims (see *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988)). The factors most relevant to the instant invention are discussed below.

The amount of experimentation required to practice the claimed invention is undue as the claims encompass any and all nucleic acid as no correlation is made between structure and function (encoding polyketide modifying enzyme). Due to the large quantity of experimentation necessary to generate the infinite number of nucleic acid that could encode the claimed protein encompassed in the genus to find the one claimed in the invention would require undue experimentation. Undue experimentation would be required for a skilled artisan to make and/or use the claimed invention

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commensurate in scope with the claims.

It is in no way predictable to be able to construct and test the claimed nucleic acid absent guidance as to a species in the genus disclosed. The protein is claimed as a polyketide modifying enzyme, however, no correlation is made between structure and function. Additionally, the specification lacks adequate guidance/direction to enable a skilled artisan to practice the claimed invention commensurate in scope with the claims. Furthermore, while recombinant and mutagenesis techniques are known in the art, it is not routine in the art to screen large numbers of proteins where the expectation of obtaining similar activity is unpredictable based on the instant disclosure. The working examples provided do not rectify the missing information in the instant specification pertaining to the claimed fragments. The nature and properties of this claim is difficult to ascertain from the examples provided as one of skill in the art would have to engage in undue experimentation to construct the variants of the claimed invention and examine the same for function. The state of the prior art provides evidence for the high degree of unpredictability as stated above. Seffernick et al. (J. Bacteriology, vol. 183, pages 2405-2410, 2001) disclose two polypeptides having 98% sequence identity and 99% sequence identity, differing at only 9 out of 475 amino acids (page 2407, right column, middle and page 2408, Fig. 3). The polypeptides of Seffernick et al. are identical along relatively long stretches of their respective sequences (page 2408, Fig. 3), however, these polypeptides exhibit distinct functions.

The specification does not provide support for the broad scope of the claims, which encompass a large genus. The issue in this case is the breath of the claims in

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light of the predictability of the art as determined by the number of working examples, the skill level artisan and the guidance presented in the instant specification and the prior art of record. This make and test position is inconsistent with the decisions of *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) where it is stated that "...scope of claims must bear a reasonable correlation to scope of enablement provided by the specification to persons of ordinary skill in the art...". Without sufficient guidance, determination of having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive and undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). Thus, for all these reasons, the specification is not considered to be enabling for one skilled in the art to make and use the claimed invention as the amount of experimentation required is undue, due to the broad scope of the claims, the lack of guidance and working examples provided in the specification and the high degree of unpredictability as evidenced by the state of the prior art, attempting to construct and test all nucleic acids of the claimed invention would constitute undue experimentation. Making and testing the infinite number of possible nucleic acid to find one that functions as described is undue experimentation. Therefore, applicants have not provided sufficient guidance to enable one of skill in the art to make and use the claimed invention in a manner that reasonably correlates with the scope of the claims, to be considered enabling.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 17-18 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by McDaniel et al. U.S. Patent No. 6,524,841, October 8, 1999).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

McDaniel et al. teach recombinant nucleic acids that encode all or a portion of the megAI gene of the megalomicin polyketide synthase of *Micromonosporas megalomicea* (abstract). McDaniel et al. disclose modifying enzymes which include those enzymes involved in the conversion of 6-DEB into a megalomicin, said enzymes

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are encoded by megF, megK among others (paragraph [45]), see claims 1-3. Mc Daniel et al. also teach a host cell (paragraph [16]), vector (paragraph [14]) and method of making said protein (paragraph [12]), see claims 17-18 and 21-22. Therefore, the limitations of the claims are met by the reference.

9. Claims 1-3, 16-17 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Volchegursky et al. (Molecular Microbiology, vol. 37 (4), pages 752-762 , 2000).

Volchegursky et al. teach the cloning and sequencing of a 48kb segment of the megalomicin (meg) biosynthetic gene cluster which contains the modular polyketide synthase (PKS) and the complete pathway for megosamine biosynthesis. Volchegursky et al. disclose enzymes such as megF (see claims 1-3, page 752 and 755 of the reference). The process used by Volchegursky et al. involves host cells, vector and said process produced the enzymes as claimed, therefore, claims 17-18 and 21-22 are anticipated (see pages 759-760). Therefore, the limitations of the claims are met by the reference.

Conclusion

10. No claims are allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr, can be reached at (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope Robinson, MS

Patent Examiner

**HOPE ROBINSON
PATENT EXAMINER**

4/14/06